



A4-123

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

WILLIAM PATRICK APPS

Group Art Unit: 3727

Examiner: S. Castellano

Serial No.: 09/785,100

Filed: February 15, 2001

For: NESTABLE DISPLAY CRATE FOR BOTTLE CARRIERS

Attorney Docket No.: RPC 0559 PUS

**REPLY BRIEF TO
SUPPLEMENTAL EXAMINER'S ANSWER**

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Sir:

This brief is filed in reply to the Examiner's Answer mailed October 29, 2003.

Supplemental Argument

(6) Issues

Appellant does not challenge Issues A - C as presented by the Examiner which do not substantively change these issues as presented by Appellant. However, it is important to note that the Examiner has withdrawn Issues D and E.

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I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

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(10) Grounds Of Rejection

The Examiner is now presenting his fifth attempt to establish grounds of rejection. Technically the grounds remain the same, i.e., that all or some of the claims are anticipated by three references. Each explanation, however, represents significant shifts of position by the Examiner. He now finally provides detailed explanations for the rejections, which should have been provided in his initial rejection on October 19, 2001, three years ago, and in the initial final rejection on May 22, 2002, more than 28 months ago. Please note that the Examiner reopened prosecution of the application *after* Appellant had prepared and filed its initial Appeal Brief. This was to add the double patenting rejections now abandoned by the Examiner after an additional Appeal Brief and Reply Brief were filed addressing these issues.

Due to the failure of the Examiner to timely explain his rejections, Appellant has lost valuable time and spent large amounts. Yet, until now, Appellant had no reasonable chance to respond to the substance of the Examiner's bases for rejection due to the lack of explanation. That this is occurring in a Supplemental Reply Brief underlies the unfairness of the Examiner's actions. However, Appellant hopes the case can now be decided expeditiously so that Appellant's assignor can enjoy the protection to which it is entitled.

To properly understand the grounds of rejection, a history of their evolution is appropriate.

(a) First Rejection - October 19, 2001

This case was filed February 15, 2001. After several preliminary amendments, the Examiner issued the first office action on October 19, 2001. The only rejections or objections were as follows:

2. Claims 1-51 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Apps et al.('461).
3. Claims 15-19, 21-26, 50 and 51 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Apps et al. ('482).

4. Claims 28-30, 32-39 are rejected under 35 U.S.C. 102(b) and/or (e) as being clearly anticipated by Koefeldt ('843).

No further explanation for the rejections was presented by the Examiner.

(b) Second Rejection (Final) - May 22, 2003

The Appellant responded with one minor amendment to one of the six independent claims and with argument as to why the rejections were improper.

On May 22, 2002, a final office action was mailed. It stated:

Claims 1-51 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Apps et al. ('461).

Claims 15-19, 21-26, 50 and 51 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Apps et al. ('482).

Claims 28-30, 32-39 are rejected under 35 U.S.C. 102(b) and/or (e) as being clearly anticipated by Koefeldt ('843).

Applicant's arguments filed April 30, 2002 have been fully considered but they are not persuasive. Applicant states that the crate is intended for supporting bottle carriers and that the references provide support only for individual bottles rather than bottle carriers. The same surfaces that can support the individual bottles are just as capable of supporting bottle carriers.

No further explanation for the rejections was presented by the Examiner. No attempt was made to support the allegation that the "same surfaces that can support the individual bottles are just as capable of supporting bottle carriers" or explain how the allegation related to the claims.

Appellant appealed on November 22, 2002. Appellant mailed its Appeal Brief in January 31, 2003.

(c) Third Rejection - May 22, 2003

In response to the Appeal Brief, the Examiner reopened prosecution of the application and issued a new office action on May 3, 2003. It stated:

Claims 1-51 are rejected under 35 U.S.C. § 102(e) as being anticipated by Apps et al. ('461). [Corresponding to Issue A.]

Apps et al. ('461) discloses a low depth nestable display crate which holds two liter beverage bottles made of polyethylene terephthalate (PET) material and is inherently capable of holding bottle carriers such as beverage cozys with a beer bottle in each beverage cozy.

Claims 15-19, 21-26, 50 and 51 are rejected under 35 U.S.C. § 102(e) as being anticipated by Apps et al. ('482). [Corresponding to Issue B.]

Apps et al. ('482) discloses a low depth nestable display crate which holds beverage bottles and is inherently capable of holding bottle carriers such as beverage cozys with a beer bottle in each beverage cozy or larger two-pack, four-pack, six-pack or eight-pack bottle carriers.

Claims 28-30, 32-39 are rejected under 35 U.S.C. § 102(b) and/or (e) as being anticipated by Koefeldt ('843). [Corresponding to Issue C.]

Koefeldt ('843) discloses a low depth nestable display crate which holds one liter beverage bottles (B) in a 3 by 5 array (see Fig. 16-18) and is inherently capable of holding bottle carriers such as beverage cozys with a beer bottle in each beverage cozy or larger two-pack, four-pack, six-pack or eight-pack bottle carriers.

The Examiner also presented purported double patenting rejections [corresponding to Issues D and E], which are withdrawn in the Supplemental Examiner's Answer. No further explanation for the art rejections was presented by the Examiner. We see for the first time, reliance on general references to undisclosed or explained "beverage cozys" and "larger two-pack, four-pack, six-pack or eight-pack bottle carriers."

(d) First Examiner's Answer - October 29, 2003

In the Examiner's initial Answer, he summarily asserted the grounds of rejection were "set forth in prior Office Action, Paper No. 15." Yet, in support for his § 102 arguments, the Examiner took new positions, including that "Bottle carrier refers to any *hypothetically* designed bottle carrier" (Page 5, emphasis added.) He went on to suggest this includes "a carrier of much smaller dimensions for bottles of significantly smaller dimensions or a carrier which holds only one bottle, such as a beverage cozy. There are many bottle carriers for use with multiple bottles of 1 oz. or smaller capacity which are used in chemical test kits to test ph or ammonium levels in pool or aquarium water or to perform chemical testing in a lab." (Page 5.) No beverage cozy or chemical test kits were disclosed by the Examiner for purposes of the rejection.

The Examiner further stated in his initial Answer (page 5) that:

An alternate view of the prior art considers the disclosed stack of crates. The anticipatory prior art references are all nestable/stackable crates. When two or more of the crates are nested or stacked, the lower crate is deemed a crate as specified by the invention and the upper crate is a bottle carrier as specified by the invention. Each of the bottle carriers holds at least six bottles.¹

His Answer continued by making additional arguments, which were *not* found in the Office Action, regarding the references.

These were significant shifts in the Examiner's position and required further argument by Appellant in the initial Reply Brief.

Also, the Examiner took the position with regard to issues D and E regarding double patenting in his Answer (page 7) that "The examiner did not intend to make an obviousness-type double patenting rejection." Despite this, he proceeded to make

¹ The Examiner never attempted to apply this "view" to any claim – understandably since numerous claim limitations are not met in such an application of the prior art.

arguments for obviousness-type double patenting in his Answer, which were answered in Appellant's Reply Brief.

(e) Supplemental Examiner's Answer - August 19, 2004

The Board recognized the improper summary and incomplete nature of the Examiner's arguments. Therefore, the Board in its opinion of July 14, 2004 remanded the case to the Examiner and required a Supplemental Examiner's Answer.

In the Supplemental Examiner's Answer of August 19, 2004, the Examiner again changes position. He now provides six pages giving more detailed bases for the prior art rejections, which should have been provided in his initial rejection on October 19, 2001, three years ago, and in the initial final rejection on May 22, 2002, more than 28 months ago. The Examiner also summarily withdraws the double patenting rejections, purportedly due to a lack of "motivation"(!?!).

(11) Argument

In explaining the “Grounds for Rejection,” the Examiner attempts to modify the references to allege that they have the capability of holding “any hypothetically designed bottle carrier” in the form “a carrier of equal or smaller dimension such as a beverage cozy.” (Supp. Answer, pp. 10-11.) However, use of bottle carriers in the crates disclosed in the references is not taught in any of the references. To the contrary, they are not directed to use with bottle carriers, but rather are designed to interact with single bottles. (See, e.g., Apps ‘461 – Col. 6, ll. 1-27, Figs. 1 and 14; Apps ‘482 – Col. 4, ll. 53 - 60, Figs. 1 and 11; Koefeldt ‘843 – Col. 5, ll. 11-30, Figs. 3, 14 and 16.) This attempt to read use with bottle carriers into the references is improper:

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. . . Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge **does not grant a license to read into the prior art reference teachings that are not there.**

Motorola, Inc. v. Interdigital Tech. Corp., 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997) (emphasis added).

Since the references do not teach nor disclose any use with bottle carriers, the argument that they are inherently suitable for such use is not sustainable. Rejections must be premised on evidentiary facts, not unsupported opinion. *In re Soni*, 137 USPQ 797 (CCPA 1963).

Even if one accepts the Examiner’s argument that use of bottle carriers in the references is inherent, no “beverage carriers” are disclosed in the prior art that when used with the crates of the references meet the claim language. Although use with hypothetical beverage cozies is alleged, no beverage cozies nor chemical test kits are disclosed so to enable Appellant or the Board to assess the allegation.

Appellant does not believe one skilled in the art would recognize a beverage cozy as a bottle carrier. The definition of cozy is found in many dictionaries — all substantially similar to that found in THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 4th Edition 2000 which defines the noun cozy as “a padded or knitted covering placed especially over a teapot to keep the tea hot.” While not found in the dictionary, Appellant is aware of padded coverings for beverage cans to keep the beverage in the can cool. However, Appellant is not aware of any cozys being considered bottle carriers. The allegation that a bottle cozy, as that term is normally understood to be directed to use with a single teapot or can, is a “bottle carrier” for purposes of the claims, is not supported by any understanding of those in the art.

To the contrary, the specification defines bottle carriers as being any “differently grouped multi-packs,” i.e., for more than one bottle per carrier. See, e.g., specification, page 3, ll. 11-16:

Directed to achieving these objects, a new low depth, nestable display crate for bottle carriers is herein provided. The preferred configuration is for four six-pack carriers of bottles. It will be understood that while the preferred embodiment of the present invention is configured for retaining six-pack bottle carriers, the crate may be used to store or transport any type of container and differently grouped multi-packs.

Additionally, the Examiner in the introduction to the Response to Argument of the Supplemental Answer (page 11) suggests:

An alternate view of the prior art considers the disclosed stack of crates. The anticipatory prior art references are all nestable/stackable crates. When two or more of the crates are nested or stacked, the lower crate is deemed a crate as specified by the invention and the upper crate is a bottle carrier as specified by the invention. Each of the bottle carriers holds at least six bottles.

This unusual argument is, however, not pursued in application to any claim, probably due to the large number of claim elements not present when using such a “bottle carrier.”

Issue A:

Apps ‘461 neither teaches nor discloses the invention of Claim 1. The Examiner in the Grounds of Rejection attempts to read Claim 1 on the Apps ‘461 crate. (Supp. Answer, pp. 4-5.) However, the entire argument is premised on his improper attempt to define the hypothetical cozy being a “bottle carrier” despite no such understanding in the art and the definition of bottle carrier set forth in the specification requiring that it be a “multi-pack.” Since Apps ‘461 does not disclose or allow its use with a bottle carrier, it cannot anticipate the claim.

Further, a padded cozy would not be inherently suitable for use in Apps ‘461. Apps ‘461 teaches that items being placed in the crate need to be seated properly for the crate to work. See, for example, column 1, lines 26-43; column 2, lines 1-13; column 6, lines 1-62. Placing a small bottle surrounded by a padded covering would not be suitable for use in the crate since the resultant movement of the bottle within the cozy would be intolerable in a bottle case, even if the cozy was considered a bottle carrier. Apps ‘461, as does this application, requires surfaces to maintain the bottles (in the crate of Apps ‘461) and bottle carriers (in the crate of the current application) in an upright position. Thus, the claim language requiring that the lower wall portion include “an interior bottle carrier support surface” would not be met with flexible cozys.

The Examiner, however, in the Response to Argument raises an alternative hypothetical bottle carrier, stating:

Of course, a bottle carrier sized to hold six-12 oz. bottles in a 2 X 3 array would not fit in the space designed for the circumference of a two-liter bottle. However, six-1 oz.

bottles in a carrier of approximately 2 in. by 3 in. dimensions would fit in the space designed for a two-liter bottle and each bottle pocket could hold a separate carrier.

The Examiner however does not attempt to read Claim 1 on the hypothetical carrier for six-1 oz. bottles. This is because such a “bottle carrier” would not meet the claim limitation in Claim 1 that there be display openings between the tooth members “wherein said display openings are sized to reveal labels on the bottle carriers for displaying the bottle carriers in a loaded crate.” The small “bottle carrier,” let alone any hypothetical label on the carrier, would not extend above the lower wall portion so it could not be seen in the display openings of the Apps ‘461 crate disclosed. All the other claims have similar requirements not met by Apps ‘461 and the “bottle carriers” envisioned by the Examiner.

Claims 2 and 16 further require spaced tooth members extending upward from the lower wall portion and having interior teeth panels which are flat to provide lateral support to bottle carriers loaded in the crate. The Examiner states that “the pylons 58 have flat interior surfaces capable of providing lateral support to bottle carriers.” (Supp. Answer, p. 6.) However, the flat surfaces identified by the Examiner as element 36 in the Apps’ 461 patent fail to meet the requirements of the claims. Assuming a cozy would extend high enough to contact a portion of the pylon above the lower wall portion, all of the surfaces of the pylons facing the pocket are concavely curved and not flat, as best seen in Figure 2. *See also*, column 6, lines 30-35 (“Pylons 58a disposed in the corners between two adjacent walls have one *curved surface* 34. Pylons 58 disposed on side walls 12, 16 have two curved surfaces 34 and one flat surface 36 disposed therebetween. *The two curved surfaces 34 help define two separate and adjacent bottle retaining pockets 32.* The flat surface 36 is disposed between these two bottle retaining pockets.” (Emphasis added.)) Amazingly, the Examiner recognizes this in his discussion regarding Claim 22 where he admits that “the upper edge of pylon 58 which is directed to face the bottles is concavely curved” (Supp. Answer, p. 11.) As noted above, the hypothetical six 1 oz. bottle

carrier would not even extend above the lower wall portion so to contact *any* surface of pylon 58 above the lower wall portion. Thus, the claim limitations of Claims 2 and 16 are not met.

With regard to Claim 22, there is an additional requirement that the spaced tooth members extending along said side walls have an upper edge with at least one rounded portion. Nothing meeting this requirement is found in the Apps '461 patent. The Examiner argues "the upper edge of pylon 58 *which is directed to face the bottles* is concavely curved and includes a rounded portion." (Supp. Answer, p. 6, emphasis added.) The part of pylon 58 directed to face the bottles is a side of a pylon, not an upper edge. The upper edges of the pylons, as best shown in Figure 5, are not rounded. The limitations of Claim 22 are not met.

Claim 31 further requires that the inner surface of the side wall lower portion between spaced tooth members have a plurality of ribs extending inwardly perpendicular therefrom. Though there is a rib 35 extending inwardly perpendicular from the inner surface of the outer wall between the spaced tooth members, there is not a plurality of such ribs as claimed. The claim limitations of Claim 31 are not met.

Since there is nothing in the Apps '461 that discloses and teaches the claimed inventions, the rejection under § 102 is improper.

Issue B:

The Examiner's primary argument is that Apps '482 has the space to hold two or three six-pack carriers transversely oriented with respect to the crate's longitudinal axis. The Examiner also argues that Apps '482 is "even more capable than Apps ('461) of holding smaller bottle carriers designed for fewer bottles designed for bottles of smaller capacity." (Supp. Answer, p. 12.)

While in hindsight bottle carriers could be loosely placed in Apps '482 (though this is not disclosed or suggested), they cannot be held there in the manner taught by Apps '482 or required by the claims so to function as a low depth nestable display crate for bottle carriers. The claims rejected by the Examiner as anticipated by Apps '482 require that the lower side wall portion have interior bottle carrier support surfaces. The two or three six-pack carriers transversely oriented with respect to the crate's longitudinal axis as envisioned by the Examiner when placed in the open area of the Apps '482 crate would be prevented from interacting with the interior of the lower wall portion by surface 56.

Smaller bottle carriers, designed for fewer bottles, or designed for bottles of smaller capacity would similarly either not contact the lower side wall portion so to create interior bottle carrier support surfaces or would be so small as to not extend over the side wall, thereby failing to have labels seen through any alleged display openings, another requirement of the claims. (The smaller bottle carriers, as apparently envisioned by the Examiner, would also run the risk of falling out of the crate through the openings in the end walls under the handles. See, Figs. 1 and 12.)

The Examiner states with regard to Claim 16 that surface 56 forms a surface of the teeth panel that is flat and coplanar with the interior bottle surface carrier support surfaces. As recited above, Appellant does not see any interior bottle surface carrier support surfaces when six-pack carriers are positioned in the Apps '482 crate. More importantly, the flat surfaces 56 are not coplanar with any of the arcuate lower wall portion, let alone any alleged interior support surface of the lower wall portion.

Since there is nothing in the Apps '482 that discloses and teaches the claimed inventions under Issue B, the rejection under § 102 is improper.

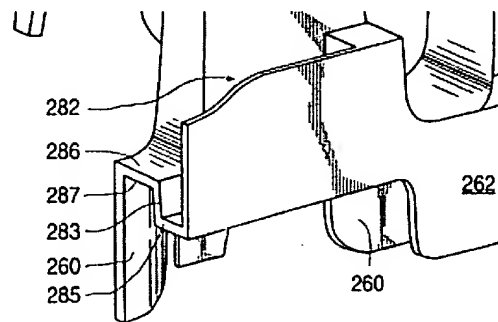
Issue C:

Koefeldt '843 is said by the Examiner to have space to hold three six-pack carriers transversely oriented with respect to the crate's longitudinal axis. Koefeldt '843 is also said by the Examiner to be even more capable than Apps '461 of holding smaller bottle carriers designed for fewer bottles or designed for bottles of smaller capacity.

However, Independent Claim 28, from which all the rejected claims depend, requires:

a handle bar integrally molded with said tooth members along said endwalls and said lower wall portion defining a cut-out, said cut-out providing said handle bar with complete clearance below said handle bar, and complete clearance above said handle bar from a stacked crate thereabove, and providing sufficient clearance between said handle bar and the bottle carriers loaded in said crate to enable a user's hand to encircle said handle bar.

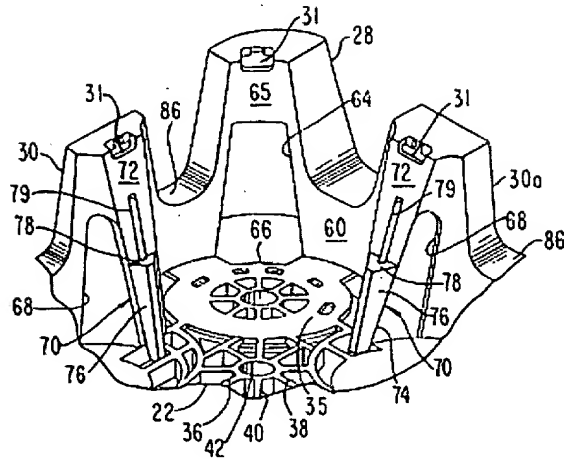
The Examiner argues handle 282 shown in Figure 16 may be encircled by a user's hand and/or fingers. However, if one looks at the Figure 19, which shows the handle of handle 282 in more detail, one recognizes that a hand or fingers cannot encircle the handle as required.



From FIG 19, Koefeldt '843

Claim 33, however, requires that teeth panels be provided on the interior side of tooth members with the panels being flat to provide lateral support to the bottle carrier surfaces loaded in the crate. The Examiner argues that panels 70 and 72 are flat and capable of providing support to the bottle carriers. However, the flat panels must be on the spaced tooth members "extending upwardly said lower wall portion" (See Claim 28, upon which

Claim 33 is dependent). As best shown in Fig 14 of Koefeldt '843, Panel 70 is comprised of



upper panel portion 72 and lower panel portion 74 on which is positioned stop 76. The lower portion 74 does not extend upwardly from the lower wall panel and in fact is below the top of the lower wall portion. Thus, neither lower panel portion 74 nor stop 76 can satisfy the claim requirement. Panel 72 does extend above the lower wall portion but at an angle away from the surface of the bottle carriers as positioned by the Examiner and has a central rib 79. Thus, panel

72 would not contact the bottle carrier to provide lateral support and central rib, even it in contact, is not a flat panel.

Since there is nothing in the Koefeldt '843 that discloses and teaches the claimed invention of Claim 33, the rejection under § 102 is improper.

Issues D and E:

These rejections were withdrawn in the Examiner's Supplemental Answer.

Conclusion

For the reasons discussed above, Appellant believes the recited rejections of Claims 1-51 are in error. For the reasons discussed above, Appellant believes the recited rejections of Claims 1-51 are in error. Thus, reversal is respectfully requested.

Please charge any additional fee or credit any overpayment in connection with this filing to our Deposit Account No. 02-3978.

Respectfully submitted,

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